

REMARKS

This amendment is submitted in response to the Final Office Action of January 28, 2008. Reconsideration and allowance of the claims is requested. In this Final Office Action, claim 1 is objected to as being informal. The requested correction has been made, which should eliminate this objection.

In the Final Office Action, claims 1-3, 7-9, 14-17 and 22-25 are rejected under 35 U.S.C. 103 as unpatentable over Master (U.S. 2002/0138716). Claims 4-6, 18, 20 and 21 are rejected as unpatentable over Master in view of Fallside (U.S. 6,326,806). These rejections are respectfully traversed.

In response to the previous Office Action, Applicant submitted a Declaration by one of the inventors, Mr. Chuang, under 35 U.S.C. 131, in which states that he conceived the invention prior to the publication date of the Master reference (i.e., prior to September 26, 2002). Such a declaration eliminates Master as a reference.

The Examiner contends that the declaration is inadequate because, as stated at paragraph 41 of the Final Office Action, “[t]here are no dates on the documents of the provisional application showing they were written or in the process of being written prior to Master’s publication date.” This contention is incorrect on its face. The primary document of the provisional application is the Master published application ‘716, which also forms the basis for all the prior art rejections. Master ‘716 was filed on September 26, 2002. This document, which the Examiner concedes discloses but does not claim the present invention, was certainly prepared prior to the publication date of September 26, 2002 which the Examiner relies on. Chuang’s declaration states that he conceived the invention, as disclosed in Master ‘716 and claimed herein. These facts, considered together, are conclusive evidence that he was in full possession of the relevant part of the invention prior to September 26, 2002. No other conclusion is logical.

At paragraph 42 of the Final Office Action, the Examiner next argues that there is no explanation of how the evidence provided shows conception of the claimed invention and requests a mapping of the provisional onto the claims. However, on page 2, paragraph 6, of the Final Office Action, the Examiner states, “the Examiner agrees (that the provisional patent application) discloses the claimed invention.” The Applicant has no duty to provide further evidence from the inventor or by further argument for a point which the Examiner has already conceded. The Examiner goes on at paragraphs 7-22 to explicitly spell out how

the relevant portions of the claims are supported by the Master patent publication. Therefore, this requirement at paragraph 42 must be withdrawn.

Finally, at paragraph 43, the Examiner states that there is no proof that the provisional application was diligently caused to be filed. On the contrary, this statement is explicitly made by inventor Chuang in his declaration. Further, it has been held at Haskell v. Coleburne 671 F.2d. 1362 (CCPA 1982) that a time period of 6 days to file an application is acceptable for establishing diligence. Here, Applicant is only required to account for a time period of 5 days, that is, the period between the publication of the Master patent and the filing date of the present application (see MPEP 2138.06). Therefore, the ruling of the CCPA has established that a time period of 5 days elapsed in filing is acceptable in accounting for the diligence of the inventor in filing his application.

In summary, Applicant by virtue of the evidence submitted comprising Master '716 and the inventor's declaration (which explicitly refers to the published application as setting forth a portion of his invention), has clearly established conception and diligence. Further, the Examiner has already conceded and made a part of the record of this case that the provisional application fully supports every element of the claims. The Master publication clearly supports all the relevant portions of the claims. Therefore, the Master publication has to be disqualified as prior art.

For the foregoing reasons, reconsideration of this rejection and allowance of the claims is respectfully requested.

Respectfully submitted,



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